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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/802,278

03/08/2001

Ari Juels

1048-005

6866

47653

7590

06/05/2008

BAINWOOD HUANG AND ASSOCIATES LLC  
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WESTBOROUGH, MA 01581

EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

06/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/802,278	<b>Applicant(s)</b> JUELS, ARI	
	<b>Examiner</b> Pierre E. Elisca	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to Applicant's response filed on 03/11/2008.
2. Claims 1-26 are currently pending.

### **ALLOWABLE SUBJECT MATTER**

3. Claims 18-23 are allowed over the prior art of record.

### ***Claim Objections***

4. Claims 9-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 and 24-26 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **the newly found prior Hertz Frederick S. M. (U.S. PG. Pub 2003/0037041; 12/09/1996)** in view of Walker et al (U.S. Pat. No. 6,249,772).

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As per claims 1-8 **Hertz 041**" substantially discloses a system/method for automatic determination of customized and promotions or advertisements (which is readable as Applicant's claimed invention wherein said a method for enabling targeted information retrieval while protecting consumer privacy) comprising:

providing a plurality of elements of information (see., abstract, specifically target objects, [0002], [0014], [0015], and [0018]);

specifying a negotiant function designed to accept a plurality of elements of data associated an information request as output, said information request designating at least one element of information to present to the consumer from among a plurality of elements of information (see., abstract, [0014], [0018], [0019], [0109], specifically [0205], negotiate the release of user-specific information and credentials from proxy server); and

distributing the negotiant function (see., abstract, [0014], [0015], [0018], [0205]). **Hertz 041**" fails to explicitly disclose the step of distributing the negotiation function to a consumer for execution by said consumer. However, Walker discloses a system/method wherein **a consumer negotiates a price for a selected product**, the consumer is assured that he will actually receive the product (see., abstract, col 10, lines 35-45). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the privacy-protected targeting system of **Hertz 041**" by including the limitation detailed above as taught by Walker because this would allow consumer to significantly affect the price of the products of the manufacturer.

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7. Claims 1-8 and 24-26 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **the newly found prior Hertz Frederick S. M. et al (U.S. Pat. No. 5,754,939; 05/19/1999)** in view of Walker et al (U.S. Pat. No. 6,249,772).

As per claims 1-8 **Hertz 939** substantially discloses an inventive concept "of customizing electronic identification of desirable object (which is readable as Applicant's claimed invention wherein said a method for enabling targeted information retrieval while protecting consumer privacy) comprising:

providing a plurality of elements of information (see., abstract, specifically target objects, col 1-col18);

specifying a negotiant function designed to accept a plurality of elements of data associated an information request as output, said information request designating at least one element of information to present to the consumer from among a plurality of elements of information (see., abstract, col 1-col18, negotiate the release of user-specific information and credentials from proxy server); and

distributing the negotiant function (see., abstract, [0014], [0015], [0018], [0205]). **Hertz 939** fails to explicitly disclose the step of distributing the negotiation function to a consumer for execution by said consumer. However, Walker discloses a system/method wherein **a consumer negotiates a price for a selected product**, the consumer is assured that he will actually receive the product (see., abstract, col 10, lines 35-45). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the privacy-protected targeting system of **Hertz 939** by including

the limitation detailed above as taught by Walker because this would allow consumer to significantly affect the price of the products of the manufacturer.

## RESPONSE TO ARGUMENTS

8. Applicant's arguments with respect to claims 1-23 have been fully considered but they are not persuasive.

## REMARKS

In response to Applicant's arguments filed on 03/11/2008, Applicant argues that the cited references fail to disclose the recited feature:

a. The drawings are accepted.

b. "distributing a negotiant function to a consumer for execution by the consumer".

However, the Examiner respectfully disagrees with Applicant's characterization of the prior art. **Hertz 041" and 939"** fail to explicitly disclose the step of distributing the negotiation function to a consumer for execution by said consumer. However, Walker discloses a system/method wherein **a consumer negotiates a price for a selected product**, the consumer is assured that he will actually receive the product (see., abstract, col 10, lines 35-45). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the privacy-protected targeting system of **Hertz 041 and 939"** by including the limitation detailed above as taught by Walker because this would allow consumer to significantly affect the price of the products of the manufacturer.

c. Applicant also maintains that the cited references fail to disclose the limitations of claim 3 wherein said receiving a negotiant function and executing the negotiant function. Upon execution, the negotiant function generates an information request. The information request designates at least one element of information from among a plurality of elements of information. As mentioned before, it is the Examiner believes that Walker discloses a system/method wherein **a consumer negotiates a price for a selected product**, the consumer is assured that he will actually receive the product (see., abstract, col 10, lines 35-45). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the privacy-protected targeting system of **Hertz 041**” by including the limitation detailed above as taught by Walker because this would allow consumer to significantly affect the price of the products of the manufacturer.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Pierre E. Elisca/  
Primary Examiner, Art Unit 3621

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